

APPENDIX E

IDENTIFICATION OF THE CLAIMS OF THE TARARA APPLICATION WHICH
CORRESPOND TO THE PROPOSED COUNTS

A claim corresponds to a count if, considering the count as prior art, the claim would be unpatentable over the count under 35 U.S.C. §102 or 35 U.S.C. §103. MPEP §2309.2. In other words, a claim corresponds to a count if it is directed to the same patentable invention as the count. Applying this standard, all the claims (Claims 2-28) of the Tarara application are believed to correspond to the proposed Counts as discussed below.

COUNT A

Claim 2 of the Tarara application is the same as the first alternative of proposed Count A.

Claims 3, 4 and 28 of the Tarara application depend from Claim 2 and recite optional narrower ranges of size, wall thickness and density, which fall within the ranges of Claim 2 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A. Claim 27 of the Tarara application is an independent claim which recites a density of no more than 0.3 g/cm³ rather than the density of no more than 0.1 g/cm³ recited in Claim 2. The broader density range in Claim 27 defines the same patentable invention as proposed Count A.

Claim 5 of the Tarara application depends from Claim 2, further reciting that the microspheres of Claim 1 are comprised predominantly of albumin. Use of such materials was well known in the art. *See, e.g.,* WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 2 and defines the same patentable invention as proposed Count A.

Claims 7-9 of the Tarara application all depend from Claim 2, further reciting bioactive agents. Use of bioactive agents in such compositions was well known to those of skill in the art. *See, e.g.,* WO 96/32149 at pages 13 and 14. Accordingly, Claims 7-9 of the Tarara application define the same patentable invention as proposed Count A.

APPENDIX E

Claim 10 of the Tarara application is the same as the third alternative of proposed Count A.

Claim 11 of the Tarara application depends from Claim 10, further reciting that the formulation comprises microspheres as the predominant component. Use of such formulations was well known in the art. *See, e.g.*, WO 96/32149 at page 7, line 20 to page 8, line 18, where such use is described. Accordingly, this claim is obvious in view of Claim 10 and defines the same patentable invention as proposed Count A.

Claim 12 of the Tarara application is the same as the fifth alternative of proposed Count A.

Claims 13 and 14 of the Tarara application depend from Claim 12 and recite optional narrower ranges of size and wall thickness, which fall within the ranges of Claim 12 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A.

Claim 15 of the Tarara application depends from Claim 12, further reciting that the microspheres are comprised predominantly of albumin. Use of such materials was well known in the art. *See, e.g.*, WO 96/32149 at page 6, lines 23-27, where such use is described.

Accordingly, this claim is obvious in view of Claim 12 and defines the same patentable invention as proposed Count A.

Claims 17 and 18 of the Tarara application depend from Claim 12, further reciting bioactive agents. Use of bioactive agents in such compositions was well known to those of skill in the art. *See, e.g.*, WO 96/32149 at pages 13 and 14. Accordingly, Claims 17 and 18 of the Tarara application define the same patentable invention as proposed Count A.

Claim 19 of the Tarara application is the same as the seventh alternative of proposed Count A.

APPENDIX E

Claims 20 and 21 of the Tarara application depend from Claim 19 and recite optional narrower ranges of size and wall thickness, which fall within the ranges of Claim 19 and overlap with that of the proposed Count. Therefore, these claims also correspond to proposed Count A.

Claim 22 of the Tarara application depends from Claim 19, further reciting that the microspheres are comprised predominantly of albumin. Use of such materials was well known in the art. *See*, e.g., WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 19 and defines the same patentable invention as proposed Count A.

COUNT B

Claim 6 of the Tarara application is the same as the first alternative of proposed Count B.

Claim 16 of the Tarara application is the same as the third alternative of proposed Count B.

Claim 23 of the Tarara application is the same as the fifth alternative of proposed Count B.

Claim 24 of the Tarara application is the same as the seventh alternative of proposed Count B.

Claim 25 of the Tarara application depends from Claim 24, further reciting specific blowing agents which is obvious in view of Claim 24 and defines the same patentable invention as proposed Count B.

Claim 26 of the Tarara application depends from Claim 24, further reciting that the wall-forming material is albumin. Use of such materials was well known in the art. *See*, e.g., WO 96/32149 at page 6, lines 23-27, where such use is described. Accordingly, this claim is obvious in view of Claim 24 and defines the same patentable invention as proposed Count B.